Paper No. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAY PONTE

Appeal No. 2002-2321
Application 09/283,268

ON BRIEF

Before KRASS, JERRY SMITH and BLANKENSHIP, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1-8, 10-18, 20, and 21. Claims 9 and 19 have been indicated to contain allowable subject matter.

The disclosed invention pertains to a method and system for targeting banner advertisements used in electronic commerce. The invention utilizes a computer system that improves relevancy

ranking of advertisements to user queries. This relevancy-ranking improvement is achieved by establishing super-category term lists for data queries by obtaining categories of documents retrievable via the query, establishing document super-categories, mapping each category to a super-category automatically in accordance with at least one previously-determined mapping of categories to super-categories, and creating a super-category term list including the terms of the super-category as well as the terms of the categories mapped to the super-category.

Representative claim 1 is reproduced as follows:

1. A method executed in a computer system for establishing super-category term lists for use in performing a data query, comprising:

obtaining categories of documents that may be retrieved in accordance with said data query, each of the categories having at least one term;

establishing super-categories for the documents;

mapping each of the categories to a super-category, wherein at least one of said categories is mapped to a super-category automatically in accordance with one or more previously determined mappings of categories to super-categories; and

establishing a super-category term list for each term appearing in a super-category or a category, each element of a list including the terms in the super-category and the terms in the categories that are mapped to that super-category.

The examiner relies on the following references:

Cochran et al. (Cochran)	5,206,949	Apr. 27, 1993
Kamakura et al. (Kamakura)	6,047,310	Apr. 4, 2000 (filed Jul. 10, 1996)

Claims 1, 3-8, 10, 11, 13-18, 20, and 21 stand rejected under 35 U.S.C. § 102(b) as being anticipated by the disclosure of Cochran.[1] Claims 2 and 12 stand rejected under 35 U.S.C. § 103. As evidence of obviousness, the examiner offers Cochran in view of Kamakura.

Rather than repeat the arguments of appellant or the examiner, we make reference to the briefs and the answer for the respective details thereof.

[1] Although the examiner's answer states on page 3 that claims 1, 3-8, 10, 11, 13-18, 20, and 21 are rejected under 35 U.S.C. § 102(b), the examiner subsequently states that appellant's arguments with respect to claims 3, 4, 10, 13, 14, and 20 are "deemed to be persuasive." [examiner's answer, page 5.] After considering the examiner's admission in light of the totality of the record before us, we presume the examiner did not intend to maintain the rejection with respect to claims 3, 4, 10, 13, 14, and 20. Rather, we presume the examiner intended to object to those claims as being dependent upon a rejected base claim, but would consider such claims to be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Therefore, we consider this rejection as applied only to claims 1, 5-8, 11, 15-18, and 21.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner, and the evidence of anticipation and obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellant's arguments set forth in the briefs along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the evidence relied upon does not support either of the rejections made by the examiner. Accordingly, we reverse.

We consider first the rejection of claims 1, 5-8, 11, 15-18, and 21 under 35 U.S.C. § 102(b) as being anticipated by the disclosure of Cochran. Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention as well as disclosing structure which is capable of performing the recited functional limitations. RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984), cert. dismissed, 468 U.S. 1228 (1984); W.L. Gore & Assoc., Inc. v. Garlock, Inc., 721 F.2d 1540, 1554,

220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

The examiner has indicated how he has read the claims on the disclosure of Cochran [answer, pages 4 and 5]. Cochran discloses a database search and retrieval system that displays search terms created from dynamic lists obtained from data fields corresponding to a selected category. The data fields are obtained from each record in the database [Cochran, col. 3, lines 38-43].

With regard to claim 1, appellant first argues that Cochran does not disclose establishing super-categories for documents [brief, page 5]. Although appellant concedes that Cochran discloses a super-category (Criteria) and a group of categories (Rate, Size, Meeting Rooms, Activities on Site, and Activities off Site), appellant argues that this teaching merely shows the existence of a super-category, but does not teach or suggest a super-category for documents retrievable in accordance with a data query as required by the claims. In response, the examiner notes that because Cochran discloses (1) each term of the dynamic list corresponding to at least one database record, and (2) database records classified in different categories (e.g., "Article," "Book Review," etc.) within a super-category (e.g.,

"Legal Resource Index"), the reference reads on the limitation [answer, pages 3 and 4].

According to the instant specification on page 141, lines 15-17, "[t]he super-categories may consist of a sub-set of the categories, or other categories. The super-categories are preferably smaller in number than the categories...." Given the broadest reasonable interpretation of the claimed limitation of "establishing super-categories for the documents" read in light of the specification, the examiner's interpretation of the "Legal Resource Index" as a super-category for documents is reasonable.

Appellant argues that even if Cochran's "Legal Resource Index" is construed to be a super-category, the reference "does not disclose or suggest establishing super-categories for documents, but merely that a super-category could contain articles" having certain classifications [reply brief, page 4]. We disagree. Cochran's clear teaching of the existence of the "Legal Resource Index" super-category reasonably suggests that it is "established" given the term's broadest reasonable interpretation. Additionally, because the "Legal Resource Index" super-category expressly refers to documentary legal resources, it is reasonably construed as a super-category "for documents" retrievable in accordance with a data query as claimed. The

examiner has also reasonably construed the classifications of the various database records ("Article," "Book Review," etc. under categorical identifier "Article Type") as documentary categories within the "Legal Resource Index" super-category.

Nevertheless, we are convinced that the examiner has failed to show an essential claimed feature recited in independent claims 1, 11, and 21 – namely, mapping each of the categories to the super-category such that at least one of the categories is mapped to a super-category automatically in accordance with at least one previously determined mappings of categories to super-categories. The examiner argues that Cochran teaches mapping each data field from every index to the main file to form a record [answer, page 4]. In support of this argument, the examiner cites Fig. 14 of Cochran as an example of forming a record from selections from various indexes.

We are not persuaded that this example from Cochran reasonably teaches or suggests mapping each category to a super-category. But, assuming for the sake of argument that the examiner's interpretation of "mapping" indexes to the main file can somehow be construed as mapping each category to a super-category, we agree with appellant that there is no support in Cochran for automatically mapping categories to super-categories

in accordance with at least one previously determined mappings of categories to super-categories. In short, the examiner has not adequately shown where Cochran expressly teaches or suggests a previously-determined category-to-super-category mapping, much less automatically mapping categories to super-categories in accordance with this previously-determined mapping. Therefore, because Cochran does not anticipate each and every limitation in the claims, we will not sustain the examiner's rejections under 35 U.S.C. § 102(b).

We now consider the rejection of claims 2 and 12 under 35 U.S.C. § 103(a) based on Cochran and Kamakura. In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having

ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellant have been considered in this decision. Arguments which appellant could have made but chose not to make in the brief have not been considered and are deemed to be waived by appellant [see 37 CFR § 1.192(a)].

We will not sustain this rejection of the examiner because the examiner failed to establish a prima facie case of obviousness. Cochran is deficient for the reasons discussed above. The additional teachings of Kamakura do not overcome the deficiencies of Cochran. Therefore, the examiner's rejection which relies on Cochran does not establish a prima facie case of obviousness for the reasons discussed above.

In summary, we have not sustained either of the rejections made by the examiner. Therefore, the decision of the examiner rejecting claims 1, 2, 5-8, 11, 12, 15-18, and 21 is reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

ERROL A. KRASS Administrative Patent Judge	)	
JERRY SMITH Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
HOWARD B. BLANKENSHIP Administrative Patent Judge	)	

JS/ki

A B Clay
IBM Corp Intellectual Property Law
3039 Cornwalls Road
Research Triangle Park, NC 27709